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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,044	12/22/2006	Ivo Baekelmans	253773	5039
23460 7590 12/17/2007 LEYDIG VOIT & MAYER, LTD TWO PRUDENTIAL PLAZA, SUITE 4900 180 NORTH STETSON AVENUE CHICAGO, IL 60601-6731			EXAMINER HOFFMAN, SUSAN COE	
			ART UNIT 1655	PAPER NUMBER
			MAIL DATE 12/17/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/588,044

Applicant(s)

BAEKELMANS ET AL.

Examiner

Susan Coe Hoffman

Art Unit

1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address.--

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 27-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 12/06; 8/06
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The amendment filed November 8, 2007 has been received and entered.
2. Claims 1-37 are currently pending.

### ***Election/Restrictions***

3. Applicant's election with traverse of Group I, claims 1-26 in the reply filed on November 8, 2007 is acknowledged. The traversal is on the ground(s) that the claims in both groups are directed to nematocidal uses of loquat kernel. This is not found persuasive because a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The prior art composition taught by US 2001/0009903 is structurally the same as the claimed loquat kernel extract. Thus, the intended use is not considered to lend a patentable distinction to the composition. In addition, written instructions reciting an alleged novel use of a composition do not change the composition itself. *See, e.g., In re Haller* 73 USPQ 403, at 404 (CCPA 1947) ("Accordingly, the mere labeling of an old composition as an insecticide does not make it a new or different composition within the meaning of the patent statutes.") and *In re Ngai* 70 US PQ2d 1862 (CAFC 2004). Therefore, US '903 shows a lack of unity because it would anticipate the composition in Group II but not the method of use in Group I. In addition, the reference does not state that the composition has written instructions as claimed by applicant.

The requirement is still deemed proper and is therefore made FINAL.

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4. Claims 27-37 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in the reply filed on November 8, 2007.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-23, 25, and 26 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for using loquat kernel to kill, inactivate or repel root knot nematodes, does not reasonably provide enablement for killing, inactivating, or repelling all types of nematodes. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

Undue experimentation would be required to practice the invention as claimed due to the quantity of experimentation necessary; limited amount of guidance and limited number of working examples in the specification; nature of the invention; state of the prior art; relative skill level of those in the art; predictability or unpredictability in the art; and breadth of the claims. In re Wands, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

Applicant's claims are broadly drawn to killing, inactivating, or repelling all types of nematodes using loquat kernel. However, applicant's specification only demonstrates that the

loquat kernel is effective against root knot nematodes. Applicant's specification also demonstrates that loquat kernel is *not* effective against other types of nematodes (see Examples 5 and 9). Thus, the specification shows that the activity of loquat kernel against nematodes is not universal and therefore would be unpredictable. Due to this unpredictability, an artisan of ordinary skill would be forced to test the loquat kernel against all types of nematodes in order to determine if the claimed invention is able to function to the full scope of the claims. There are currently at least 12,000 known nematode species (see "nematode." *Grolier Multimedia Encyclopedia*. 2007. Grolier Online. 26 Nov. 2007. <<http://gme.grolier.com/cgi-bin/article?assetid=0205770-0>>). An artisan would be forced to test the efficacy of the loquat kernel against all of these types of nematodes. This clearly would call for undue experimentation on the part of the artisan. Thus, the claims are not considered to be enabled for the killing, inactivating, or repelling of all types of nematodes.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 1 is indefinite because it states that the method comprises "the addition of loquat kernel" but does not state that the loquat kernel is added to.

7. Claim 16 is indefinite because it is unclear how to determine what is encompassed by areas where nematodes "are likely to exist" or are "expected to move."

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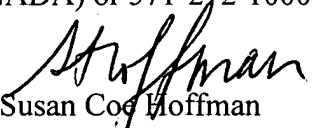
8. Claim 25 is indefinite because it is unclear how to determine what is encompassed by areas where nematodes are "believed to exist" or are "expected to move."

9. No claims are allowed. However, the use of loquat kernel to kill, repel, or inactivate root knot nematodes is considered free of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe Hoffman whose telephone number is (571) 272-0963. The examiner can normally be reached on Monday-Thursday, 9:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Susan Coe Hoffman  
Primary Examiner  
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